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Mme Nicole Fontaine
Présidente du Parlement
Européen

EDITORIAL

Je me réjouis de pouvoir apporter ma contribution au bulletin d'information de l'Office de l'harmonisation dans le marché

intérieur. Cet organisme, qui est en activité depuis un peu plus de cinq ans, joue aujourd'hui un rôle notable dans les efforts de l'Union européenne pour construire un véritable marché intérieur, notamment avec l'importance grandissante de la reconnaissance et de la protection des marques et des modèles. Les services offerts par l'Office sont d'une grande utilité aux entreprises qui cherchent à développer leurs activités pour profiter de ce marché.

Le marché intérieur est un des principales priorités du Parlement européen. D'autant plus que notre institution est colégislateur avec le Conseil en la matière. La construction du marché intérieur constitue une extraordinaire réalisation qui a des effets considérables sur la vie économique de tous les citoyens de l'Union Européenne. D'un point de vue de la production, ces derniers peuvent ainsi bénéficier des emplois et des possibilités d'emplois créés. D'un point de vue de la consommation, ils peuvent tirer avantage d'un plus large choix et de prix réduits. Certes, il convient de ne pas perdre de vue que la construction de ce marché est un processus en constante évolution et que beaucoup reste à faire dans les secteurs où les progrès ont été assez lents. Soyez assuré que le Parlement européen entend continuer à jouer pleinement son rôle pour permettre la mise en place d'un marché équilibré et ouvert sur tout le territoire de l'Union.

Suite au prochain élargissement de l'Union, il est évident que le marché prendra une toute autre dimension. Notre institution se réjouit de cette prochaine évolution, qui contribuera à l'unité du continent dans un cadre de stabilité et de sécurité politique, et qui apportera des avantages économiques et sociaux aux anciens comme aux nouveaux États membres.

Il faut cependant à tout prix éviter que cet élargissement ne porte atteinte au bon fonctionnement de l'Union Européenne. C'est la raison pour laquelle le Parlement européen souhaite que la Conférence intergouvernementale qui débutera ses travaux au mois de février pour les finir en décembre 2000, soit couronnée de succès. Nous devons absolument veiller à éviter que la Commission s'agrandisse d'une telle manière qu'elle soit ensuite incapable de fonctionner; nous devons nous assurer que le Conseil reste un organe efficace en étendant le vote à la majorité; ou encore nous devons nous assurer que le Parlement sera en mesure d'exercer son pouvoir de codécision dans tous les grands domaines législatifs, afin de donner à la législation européenne, la légitimité démocratique voulue. Par ailleurs, il est à espérer que la CIG donnera les moyens à l'Union Européenne d'intervenir efficacement dans d'autres domaines tels que la sécurité et la promotion des droits de l'homme.

Nous sommes à l'aube de grands changements et de grands défis sont à relever. Je suis cependant convaincue que l'Union Européenne continuera à apporter toujours plus d'avantages politiques et économiques à l'ensemble de ses citoyens. ■

ID NUMBERS ASSIGNED TO ASSOCIATIONS OF REPRESENTATIVES:

The Office has recently started notifying the ID numbers, generated by our EUOMARC database, to associations of representatives. Associations of representatives are urged to use their ID number in all OHIM's official forms in which their address details are requested. If the ID number is used, all additional indications such as the address, telephone and fax numbers, need not be repeated. The use of the ID number will facilitate work within the Office and avoid repetition of data.

When an association of representatives has more than one address, a separate ID number is allocated to each address.

Any modifications to the data on associations, such as change of name, address, telephone or fax numbers, together with information on any merger or dissolution of a partnership, should be notified as soon as possible to the general fax number of the Office, marked for the attention of the Technical Service, or by telephone to:

00 34-965139325. ■

European Commission Delegation
Library
2300 M Street, NW
Washington, DC 20037

Ufficio per l'Armonizzazione
nel Mercato Interno
(Marchi, Disegni e Modelli)

OAMI

Office de l'harmonisation
dans le marché intérieur
(marques, dessins et modèles)

OHMI

Office for Harmonization
in the Internal Market
(Trade Marks and Designs)

OHIM

Harmonisierungsamt
für den Binnenmarkt
(Marken, Muster und Modelle)

HABIM

Oficina de Armonización
del Mercado Interior
(Marcas, Dibujos y Modelos)

OAMI

CEE: XIV/3

SUBSTANTIATION OF EARLIER RIGHTS IN OPPOSITION PROCEEDINGS

A substantial number of oppositions fail at an early stage because the opponent has not provided sufficient evidence of the existence and validity of his earlier right within the time limits established by the Implementing Regulation and set by the Office. We give a brief overview of the approach of the Office to these requirements.

The substantiation of the earlier rights on which an opposition is based is an important and necessary task of the opponent. Both the Office and the applicant have to know in a clear and unequivocal way that the earlier rights on which the opposition is based are valid and actually belong to the opponent. If this is not the case, the opposition will have to

be rejected immediately (without examining the merits of the case) due to a lack of basis. These requirements are clearly established in Rules 16, 17, and 20 of the Implementing Regulation.

According to Rule 16 of the Implementing Regulation the opponent may file particulars of the facts, evidence and arguments in support of the opposition together with the notice of opposition or subsequent thereto. Even if he fails to do so, or if the submitted evidence at this stage is not complete, he may avail himself of a further period of four months to provide or complete the substantiation of his opposition.

This four month period begins on the date when the applicant is

notified of the opposition. Thus, if an amicable settlement is not reached during the two month «cooling-off» period, the opponent has another two months to submit further facts, evidence and arguments.

Any materials received outside the allotted term are not taken into account. Of course, the period for submitting evidence is automatically extended every time the «cooling-off» period is extended. In addition, Rule 71 of the Implementing Regulation allows the Office to extend this period provided the opponent makes his request for an extension before the expiry of the existing time limit and provides a suitable explanation justifying the request. ➤➤

ALICANTE ZWEI TAGE IM ZENTRUM DER EUROPÄISCHEN MARKENRECHTSPRECHUNG

TAGUNG DER EUROPÄISCHEN RECHTSAKADEMIE AM 18./19. NOVEMBER 1999

Unter dem Thema «Die Gemeinschaftsmarke: Rechtsprechung der Beschwerdekammern des Harmonisierungsamtes für den Binnenmarkt im Vergleich mit der nationalen Jurisdiktion» fand mit über 100 Markenrechtsexperten aus Europa einschließlich Estland, Polen und Ungarn sowie mit über 50 Praktikern des Amtes ein ungemein interessanter Informations- und Meinungsaustausch statt.

Nach der Eröffnung durch den Vizepräsidenten Dr. Alberto Casado Cerviño, den ERA-Projektleiter Antonio Pérez van Kappel und den Geschäftsführer des Deutschen Anwaltsvereins, Andreas Klein, begann Prof. Dr. Karl-Heinz Fezer, einer der großen Markenrechtskommentatoren in Deutschland, die Tagung mit seinem Referat zum Thema. «Was macht ein Zeichen zur Marke?», das in dem Appell endete, die Tore im Eintragungsverfahren, insbesondere für neue Markenformen weit aufzumachen. Damit war das Leitmotiv für den Kongreß vorgegeben und die nachfolgenden Praktiker bemühten sich, doch

gewisse Grenzlinien zu ziehen. Dr. Annette Kur vom Max-Planck-Institut in München wies darauf hin, daß die Registerbehörden nicht Marken akzeptieren dürften, die im Wirtschaftsleben offensichtlich lediglich als Störfaktoren dienen könnten. Nach der Mittagspause erläuterten unter dem Vorsitz von Oreste Montalto, dem Leiter der Rechtsabteilung des Amtes, The Hon. Mr. Justice Jacob vom Royal Courts of Justice in London und Magistrado J. Ramón Ferrándiz Gabriel, Presidente Sección 15, Audiencia Provincial de Barcelona, die nationale Rechtsprechung in Großbritannien und Spanien, die auch nach der Markenrechtsharmonisierung eine eher zurückhaltende Registrierungspraxis bevorzugen. Der erste Tag klang mit einem gemeinsamen Abendessen in «Nou Concha» aus, das dem gegenseitigen Erfahrungsaustausch einen ausgezeichneten Rahmen bot.

Am zweiten Tag stellte unter der Sitzungsleitung von Prof. Avv. Stefano Sandri, dem Vorsitzenden der Dritten Beschwerdekammer, Vanessa Edwards, wissenschaftliche

Mitarbeiterin am Europäischen Gerichtshof, dessen aktuelle Markenrechtsprechung vor. Darauf folgten David Keeling und Achim Bender als Mitglieder der Ersten bzw. Dritten Beschwerdekammer mit einer kurzen Übersicht der neuesten Entscheidungen der Kammern zu absoluten Eintragungshindernissen und den neuen Markenformen. Nach einem Mittagsempfang des Amtes im Aguilera-Gebäude informierten am Nachmittag Matthias Winkler, Vorsitzender Richter am Bundespatentgericht in München, und Eugène Lachacinski, Conseiller à la Cour d'appel de Paris, über die neue deutsche und französische Rechtsprechung, die viele neue Impulse und Anregungen aufgenommen haben.

Dieser Kongreß der Europäischen Rechtsakademie erwies die Bedeutung des gemeinsamen europäischen Meinungsaustausches für die Entwicklung eines harmonisierten Markenrechts, ermöglichte er doch durch seine Dreisprachigkeit die Überwindung der immer noch störenden Sprachbarrieren. ■

The opponent may base his opposition on one or more earlier rights, that is, national or Community trade mark registrations or applications, international registrations with effect in a Member State, or well-known marks in a Member State in the sense of Article 6bis of the Paris Convention. In addition, an opposition can be based on unregistered trade marks or signs used in the course of trade, under the terms of Article 8(4) CTMR. Any earlier right used as a basis for the opposition must be sufficiently

documented if it is to be taken into account. The only exceptions are CTM registrations or applications as the Office has the relevant information and forwards it to the applicant on its own initiative.

For all other kinds of registered marks or applications, it is up to the opponent to provide the Office with sufficient evidence covering all the formal and substantive particulars of his registration or application, namely the issuing authority, filing or registration number, territorial extent and filing or priority date

thereof, a representation of the sign as registered, the goods and services for which protection is granted, the validity of the registration and his ownership at the date the evidence is filed, as well as any other modification affecting the legal status of the mark.

Rule 16 of the Implementing Regulation makes reference to registration certificates as adequate proof of prior registrations. The Office also accepts in that regard any other equivalent public document, such as extracts of ➔

STATISTICS (SITUATION AT THE BEGINNING OF FEBRUARY 2000)

COMMUNITY TRADE MARK APPLICATIONS

BREAKDOWN BY COUNTRY

	1996-1998	%	1999 (31.12.99)	%	Total	%
TOTAL WORLD	101.820	100	41.242	100	143.062	100
TOTAL EUROPEAN UNION	61.656	60.55	26.059	63.19	87.715	61.31
BELGIQUE/BELGIË [BE]	1.623	1.59	574	1.39	2.197	1.54
DANMARK [DK]	1.705	1.67	621	1.51	2.326	1.63
DEUTSCHLAND [DE]	16.436	16.14	7.040	17.07	23.476	16.41
ELLAS/GREECE [GR]	228	0.22	111	0.27	339	0.24
ESPAÑA [ES]	6.227	6.12	2.609	6.33	8.836	6.18
FRANCE [FR]	5.632	5.53	2.735	6.63	8.367	5.85
IRELAND [IE]	788	0.77	436	1.06	1.224	0.86
ITALIA [IT]	6.659	6.54	3.263	7.91	9.922	6.94
LUXEMBOURG [LU]	397	0.39	227	0.55	624	0.44
NEDERLAND [NL]	2.854	2.80	994	2.41	3.848	2.69
ÖSTERREICH [AT]	1.608	1.58	615	1.49	2.223	1.55
PORTUGAL [PT]	576	0.57	274	0.66	850	0.59
SUOMI/FINLAND [FI]	970	0.95	387	0.94	1.357	0.95
SVERIGE [SE]	2.355	2.31	870	2.11	3.225	2.25
UNITED KINGDOM [GB]	13.598	13.35	5.303	12.86	18.901	13.21
TOTAL OUTSIDE EUROPEAN UNION	40.164	39.45	15.183	36.81	55.347	38.69
Amongst which=						
UNITED STATES OF AMERICA [US]	28.540	28.03	10.504	25.47	39.044	27.29
JAPAN [JP]	2.906	2.85	955	2.32	3.861	2.70
SWITZERLAND [CH]	1.958	1.92	705	1.71	2.663	1.86
CANADA [CA]	1.215	1.19	510	1.24	1.725	1.21
AUSTRALIA [AU]	830	0.82	411	1.00	1.241	0.87
TAIWAN [TW]	558	0.55	341	0.83	899	0.63

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	2000 (28.01.00)	1996-1999	Total
Filing dates accorded	4.906	132.780	137.686
Number classifications checked	3.413	126.970	130.383
Applications published	3.350	98.583	101.933
Oppositions	687	21.024	21.711
Contested applications	507	15.754	16.261
Appeals	103	1.086	1.189
Registered Trade Marks	2.304	59.143	61.447
Published Registered Trade Marks	737	55.513	56.250
Requests for cancellation	0	75	75

OTHER OHIM FIGURES

	ON 07.02.00
Number of professional representatives	5.453
Number of current accounts	734
OHIM Personnel	500

records or official databases and official publications, regardless of whether these databases or publications are in paper or in electronic form.

As private records and databases are not considered conclusive evidence, the issuing authority of the materials filed must be clearly mentioned in each case. Moreover, it must be borne in mind that any evidence filed must provide proof of all the particulars of the registration mentioned above. For example, a publication referring to the registration in question but not showing the representation of the mark or the goods and services concerned is not sufficient.

If the term of protection of the earlier mark has expired, the opponent must also submit a renewal certificate or, if this has not yet been issued, evidence that a request of renewal has been duly filed with the competent authorities. Similarly, when a change of ownership has taken place and is not reflected in the submitted documents, the opponent must submit evidence showing that he has taken the necessary steps for the recordal of such a transfer.

In the case of unregistered marks or other signs used in the course of trade the opponent must provide evidence of acquisition and use of the right. He also has to provide evidence that it is of more than mere local significance. In addition, he must clearly identify the conditions under which national law confers on its owner the right to prohibit the use of a later trade mark.

Since for unregistered trade marks or other signs used in the course of trade proof is not a matter of public record, the opponent may avail himself of all other means of evidence provided for in Article 76 CTMR.

The Office can only consider evidence which is submitted in the language of the proceedings. If the

evidence is not in the language of the proceedings, the opponent is required to file a translation into that language, within the term fixed by the Office for the submission of further evidence, that is at the latest the four months after notification of the opposition referred to above. Therefore, the evidence submitted by the opponent at this stage, as well as any other previously submitted document or certificate, must either be in the language of the proceedings or be accompanied by a translation. The translation by itself (without the translated document in its original language) is not considered as conclusive evidence because a translation by itself does not have independent probative value.

All the particulars of the registration must be translated, including the standard wording showing which entry corresponds to what information.

It must be borne in mind that very frequently the other party does not know the original language of the registration certificates. Consequently the standard wording showing which entry corresponds to what information is absolutely necessary for understanding clearly and unequivocally the relevant inscriptions. In addition any coded information must be clearly explained. Only administrative indications with no bearing on the case may be omitted from the translation.

As regards the authentication of the evidence, the Office accepts uncertified copies of the original documents, but it is strongly recommended that the opponent or his representative add a written, dated and signed declaration stating that the documents submitted are true copies of the originals, and that any translations are also true to the original.

It is also suggested to add a declaration of this kind to certify that the legal status of the mark has

not changed between the time when the submitted documents were issued and the time of filing of the evidence, especially if that time difference is quite substantial. In addition, the declaration should affirm that the mark is still in force, except if the certificate itself shows that the mark had already lapsed when the evidence was filed. In this case, official certification of the renewal is required, as already mentioned above. ■

USEFUL NUMBERS

Switchboard telephone number:
+ 34-96-51 39 100

General inquiries telephone numbers:
+ 34-96-51 39 243; + 34-96-513 92 72;

General inquiries fax number:
+ 34-96-51 39 173

Requests for literature (leaflets, standard forms, official texts, places where to buy Office publications, etc.), questions concerning the filing of applications, questions concerning procedure (fees, priority, seniority, etc.).

Fax number for the filing of any correspondence relating to community trade marks (applications, letters to examiners, oppositions, cancellations, appeals, Register matters, etc.): + 34 -96-51 31 344

CTM applicants and proprietors and their representatives are strongly urged to use exclusively the above fax number where faxes arrive at an automatic fax server which does not involve any printing and physical handling of documents, for all communications relating to proceedings before the Office. This will facilitate and accelerate the handling of incoming faxes, whereas the sending of such communications to other fax numbers in the Office will require additional operations and creates substantial administrative burdens.

Telephone number for obtaining information concerning means of payment:
+ 34-96-51 39 340

Opening of current accounts, bank transfers, payments by cheques, etc.

Telephone number for obtaining information about professional representatives:
34-96-51 39 117

List of professional representatives, new entries, allocation of ID numbers, authorisations, etc.

Obtaining information in relation to copies from the file and extracts from the register:
+ 34-965 139 633

Obtaining information in relation to transfers, licences, conversions:
+ 34-965 139 515 and + 34-965 139 175

Telephone number for obtaining information concerning subscriptions to our publications:
+ 34-96- 51 39 102

OHIM's Official Journal, the Bulletin of CTMS (paper and CD-ROM), EUROM, etc.

The Office's Internet site: oami.eu.int